

Amendments to the Drawings:

Applicants have amended Figure 3 to remove reference characters 220, 231, 232, 234, and 259 (as noted by the Examiner, these reference characters are not mentioned in the specification). The attached sheet of replacement drawings, which has Figure 3 thereon, replaces the original sheet of drawings having Figure 3 thereon.

Attachment: One (1) sheet of replacement drawings with Figure 3 thereon.

REMARKS

Claims 1-10 are pending in this application.

Applicant has amended claim 10. In addition, Applicant has made minor changes to the specification (including changing the Title) and the drawings. These changes do not introduce any new matter.

Applicant appreciates the Examiner's prompt indication that claim 8 defines allowable subject matter. Applicant's responses to the issues raised in the Office Action are set forth below.

Objection to the Drawings

In response to the objection to the drawings, Applicant has amended Figure 3 to remove reference characters 220, 231, 232, 234, and 259, which are not mentioned in the specification. Accordingly, Applicant submits that the drawings now comply with 37 CFR § 1.84(p)(5), and requests that the objection to the drawings thereunder be withdrawn.

Objection to the Specification

In response to the objection to the specification, Applicant has corrected the informalities identified by the Examiner. In addition, Applicant has changed the Title to "Image Processing Apparatus for Converting the Color Data by Referring to a Reconstructed Color Conversion Table and an Image Processing Method for the Same." Accordingly, Applicant requests that the objection to the specification be withdrawn.

Objection to the Claims

In response to the objection to claims 1-10 because they use the term "wherein," Applicant notes that MPEP § 2111.04 states that the determination as to whether a "wherein" clause "is a limitation in a claim depends on the specific facts of the case." In contrast, the Examiner's position appears to be that a "wherein" clause is *per se* improper. In the claims of the subject application, the use of the term "wherein" does not create any reasonable question

as to the limiting effect of the language in the claims. In other words, nothing in the “wherein” clauses cited by the Examiner can be reasonably construed as either not limiting the scope of the claim to a particular structure or as not requiring that the specified steps be performed. Accordingly, Applicant submits that the use of the term “wherein” in the claims is proper, and requests that the objection to claims 1-10 be withdrawn.

Rejection Under 35 U.S.C. § 101

Applicant respectfully requests reconsideration of the rejection of claim 10 under 35 U.S.C. § 101 as being directed toward non-statutory subject matter. Applicant has amended claim 10 to specify that the claimed program is embodied on a computer-readable storage medium, and includes computer-executable instructions causing the computer to execute the specified functions. Accordingly, Applicant submits that claim 10 now defines statutory subject matter under 35 U.S.C. § 101, and requests that the rejection of this claim thereunder be withdrawn.

Rejection Under 35 U.S.C. § 103

Applicant respectfully requests reconsideration of the rejection of claims 1-7, 9, and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Kakutani* (WO 02/32113 A1/US 7,046,844 B2). As will be explained in more detail below, the *Kakutani* reference would not have rendered the subject matter defined in independent claims 1, 9, and 10, as presented herein, obvious to one having ordinary skill in the art.

The inventor named in the subject application, Mr. Kakutani, is the same inventor named in the *Kakutani* reference applied by the Examiner. With regard to the subject matter defined in independent claims 1, 9, and 10, the *Kakutani* reference does not disclose or suggest at least the following features:

a) the use of “an encoding process, which enhances a variation in tone value of the second image data in a predetermined tone area in the first color system while compressing

the variation in tone value of the second image data in a residual tone area” (quoted from claim 1);

b) making “the color conversion table subjected to a decoding process, so as to generate an intermediate color conversion table, where the decoding process restores the variation in tone value enhanced or compressed by the encoding process” (quoted from claim 1); and

c) carrying out an encoding process with the intermediate color conversion table.

Applicant notes that the *Kakutani* reference does refer to an “encoding coefficient.” This encoding coefficient, however, is merely a simple coefficient that defines the enhancement relationship between target image data and a recording rate (see, for example, Figure 8). As such, the reference to the “encoding coefficient” in the *Kakutani* reference does not constitute either a disclosure or a suggestion of the encoding process specified in the claimed subject matter.

It is axiomatic that an obviousness rejection is proper only if the prior art discloses or suggests each and every feature of the claimed subject matter. For at least the reasons set forth above, the *Kakutani* reference does not disclose (or suggest) each and every feature of the subject matter defined in independent claims 1, 9, and 10. Thus, the *Kakutani* reference fails to raise a *prima facie* case of obviousness against the claimed subject matter. Consequently, the *Kakutani* reference would not have rendered the claimed subject matter obvious to one having ordinary skill in the art.

Accordingly, for at least the foregoing reasons, independent claims 1, 9, and 10 are patentable under 35 U.S.C. § 103(a) over *Kakutani*. Claims 2-7, each of which ultimately depends from claim 1, are likewise patentable under 35 U.S.C. § 103(a) over *Kakutani* for at least the same reasons set forth above regarding claim 1.

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of claims 1-10, as presented herein, and submits that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP058).

Respectfully submitted,
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